

**REMARKS**

Applicant respectfully requests reconsideration of the present application in view of the foregoing amendments and in view of the reasons that follow. With this amendment, claim 1 has been amended, no claims have been cancelled, and claims 6-11 have been added. A detailed listing of all claims that are, or were, in the application, irrespective of whether the claim(s) remain under examination in the application, is presented, with an appropriate defined status identifier. Claims 1-11 are pending in the application. New claim 6 is supported by the disclosure on page 14, lines 6-10, of the specification. New claim 7 is supported by line 2 from the bottom of page 9 to line 3 of page 10. New claim 8 is supported by lines 2-16 of page 21. New claim 9 is supported by the limitation canceled from claim 1. Claim 10 is supported by lines 3 and 4 from the bottom of page 8 of the specification. Claim 11 is supported by line 1 on page 10 of the specification.

**Claim Rejections - 35 USC § 112**

Claim 1 was rejected under 35 U.S.C. 112, second paragraph, as being indefinite. Specifically, claim 1 was found unclear because the phrase "each of the yarns being a sheath-core structure yarn" was found confusing in light of the phrase "heath-core structure yarn composed of two or more multifilament yarns." Applicants respectfully traverse the rejection.

Claim 1 has been amended to recite "[a] sewing thread comprising a plurality of under-twisted yarns, each of the under-twisted yarns being a sheath-core structure yarn composed of a sheath yarn comprising sheath filaments and a core yarn comprising core filaments [see page 9, lines 18-23, and Figure 1(B)(1) of the specification], the sewing thread having an upper-twist therein [see page 9, line 2 from the bottom to page 10, line 1, and Figure 1(B)(2) of the specification]."

As explained in the specification on page 9, line 18 to page 10, line 3, with reference to Figures 1(B)(1) and 1(B)(2), the thread of claim 1, exemplified by Figure

1(B)(2), has an upper-twist therein and is composed of under-twisted yarns, wherein each of the under-twisted yarns is a sheath-core structure yarn as shown in exemplary Figure 1(B)(1).

Furthermore, claim 1 has been amended to recite “wherein a part of the sheath-core structure yarn protrudes as loops on a surface of the sewing thread” as exemplified in Figure 1(B)(2) and disclosed on page 10, line 3, of the specification.

Applicants believe that the amended claim 1 is now clear and definite and respectfully requests withdrawal of the rejection.

### **Claim Rejections – 35 USC § 102/103**

Claims 1, 2 and 5 were rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Murakami et al. (US 6,074,751). Applicants respectfully request withdrawal of the rejection.

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.”

*Verdegall Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Independent claim 1 recites, *inter alia*, “[a] sewing thread comprising a plurality of under-twisted yarns, each of the under-twisted yarns being a sheath-core structure yarn composed of a sheath yarn comprising sheath filaments and a core yarn comprising core filaments, the sewing thread having an upper-twist therein.” This feature is neither taught nor suggested by Murakami.

In making the rejection, the Examiner states “[e]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself.” (Office action, page 4, lines 6-8). Applicants agree with this general proposition. None of the present claims, however, are product-by-process claims.

Independent claim 1 explicitly recites “[a] sewing thread comprising a plurality of *under-twisted* yarns, each of the under-twisted yarns being a sheath-core structure yarn composed of a sheath yarn comprising sheath filaments and a core yarn comprising core filaments, the sewing thread having an *upper-twist* therein.” These two features are structural features of the claimed thread. These features are not mere process limitations. Simply, Murakami does not teach a thread having the claimed features. Therefore, Murakami does not anticipate independent claim 1. Further, Murakami does not suggest or even provide a rational basis for a sewing thread comprising “[a] sewing thread comprising a plurality of under-twisted yarns, each of the under-twisted yarns being a sheath-core structure yarn composed of a sheath yarn comprising sheath filaments and a core yarn comprising core filaments, the sewing thread having an upper-twist therein” as recited in independent claim 1. Therefore, Murakami, even under the relaxed KSR standard would not have rendered obvious claims 1, 2, and 5 to one of ordinary skill in the art at the time of the invention.

### **Claim Rejections – 35 USC § 103**

Claims 3 - 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Murakami et al. (US 6,074,751). Applicants respectfully traverse the rejection.

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). See also MPEP 2143.03. As discussed above, independent claim 1 recites, *inter alia*, “[a] sewing thread comprising a plurality of under-twisted yarns, each of the under-twisted yarns being a sheath-core structure yarn composed of a sheath yarn comprising sheath filaments and a core yarn comprising core filaments, the sewing thread having an upper-twist therein.” This feature is neither taught nor suggested by Murakami. Indeed, as discussed above, Murakami, does not even provide a rational basis for a sewing thread comprising “a plurality of under-twisted yarns” with the thread having upper-twist therein as recited in independent claim 1.

Therefore, Murakami would not have rendered independent claim 1 or any of the claims that depend from independent claim 1 obvious to one of ordinary skill in the art at the time of the invention.

### **Conclusion**

In view of the above amendment, applicant believes the pending application is in condition for allowance. Applicants request a 2-month extension of time and submit related fees in the attached Petition. The Director is authorized to charge any additional fees necessary and/or credit any overpayments to Deposit Account No. 03-3975, referencing Docket No. 085133-0378183.

Respectfully submitted,

Dated: March 17, 2009

By: /Raj S. Dave/

Raj S. Davé  
Registration No.: 42,465  
Attorney for Applicant(s)

Customer No. 00909  
PILLSBURY WINTHROP SHAW PITTMAN LLP  
P.O. Box 10500  
McLean, VA 22102  
Telephone: 703-770-7900  
Facsimile: 703-770-7901